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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,999

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Takashi Kawasuji

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EXAMINER

EPPERSON, JON D

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

08/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,999

Applicant(s)

KAWASUJI ET AL.

Examiner

Jon D. Epperson

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 and 13 is/are rejected.
- 7) ☐ Claim(s) 12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. The Response filed June 7, 2007 Response is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Status of the Claims

3. Claims 7-14 and 17-23 were pending. Applicants amended claims 7-14 and 17-20. No claims were added or canceled. Therefore, claims 7-14 and 17-23 are still pending. Claims 17-23 are drawn to non-elected species and/or inventions and thus these claims remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), there being no allowable generic claim. Therefore, claims 7-14 are examined in this action.

Withdrawn Objections/Rejections

4. The 35 U.S.C. § 112, second paragraph rejection denoted "AA" is withdrawn in view of Applicants' amendments to the claims removing the objectionable language. The 35 U.S.C. § 112, second paragraph rejection denoted "BB" is withdrawn in view of Applicants' amendments to the claims adding the "further" substituted limitations where indicated. The 35 U.S.C. § 112, second paragraph rejection denoted "CC" is withdrawn in view of Applicants' amendments to the claims replacing "itself" with "the compound" where indicated. All other rejections are maintained and the arguments are addressed below.

New Rejections

Objections to the Claims

5. Claims 12 and 14 are objected to because of the following informalities:

A. ***Claims 12 and 14*** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7-11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. For **claim 7**, the term “Z2 is ... a C2 to C8 straight or branched alkenyl” is vague and indefinite. For example, it is not clear how a “univalent” radical like an alkenyl can link two groups together (i.e., the R1/Z3 and Z1/A groups) as required by independent claim 7. It is respectfully submitted that only a “divalent” radical like the previously claimed alkenylene can link the two groups (e.g., see acd/labs, IUPAC Nomenclature of Organic Chemistry. Retrieved at on 8/13/07 from http://www.acdlabs.com/iupac/nomenclature/79/r79_53.htm, pages 1-4 and http://www.acdlabs.com/iupac/nomenclature/79/r79_78.htm, pages 1-3, especially Rule

Art Unit: 1639

3.5 disclosing that Applicants' currently claimed "-enyl" suffix denotes a "univalent" radical" and Rule 4.3 disclosing that Applicants previously claimed "-enylene" suffix denotes a "divalent" radical). Therefore, claims 16, 19, 23 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph.

Claims Rejections - 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 7-11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

A. Claim 7 was amended in the 6/7/07 Response to change "alkenylene" to "C2 to C8 straight or branched alkenyl." Applicants stated that support for this amendment could be found at page 19, lines 10-13 of the specification as filed. However, page 19, lines 10-13 defines the term "alkenyl", a univalent radical, not the previously claimed "alkenylene," which is a divalent radical. Thus, the cited passage does not provide support for the previously claimed alkenylene divalent group since it only describes a univalent group (see also 35 U.S.C. § 112, second paragraph rejection above). If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP 714.02.

Art Unit: 1639

Conclusion

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.
August 14, 2007

/Jon D. Epperson/
Primary Examiner, AU 1639